

# **RE MARKS**

Reconsideration of the above-identified application respectfully requested.

Claims 1-5 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim that which applicants regard as the invention. Applicants' amendments to the claims in response thereto are listed above and also are detailed in the attached Marked-Up Set of Amended Claims.

With respect to claims 3 and 4, Applicants respectfully submit that the language of these claims as filed is definite and unambiguous. Alternative expressions using "or" are considered acceptable. See Manual of Patent Examining Procedure, § 2173.05(h)(II). However, to materially advance prosecution and because Applicants view the Examiner's proposed language as being identical in scope, *i.e.*, not narrowing, Applicants have made the Examiner's recommended amendments. Claim 3 has been amended to recite "part is composed of material selected from the group consisting of metal, composite, glass or combinations thereof." Claim 4 has been amended to include the identical language proposed by the Examiner.

No new matter is added by virtue of these claim amendments. Moreover, such claim amendments are ministerial as they relate to inadvertent errors in the nature of typographical, grammatical or similar errors. Accordingly, Applicants assert that no claims have been narrowed with the meaning of *Festo* (*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, \_\_ US \_\_, 112 S.Ct. 1831, 152 L.Ed.2d 944, 62 USPQ2d 1705 (2002)). See also *Interactive Pictures Corp. v. Infinite Pictures Inc.*, Fed Cir., No. 01-1029, December 20, 2001 (addition of the words "transform calculation" was not a narrowing amendment because that addition did nothing more than make express what had been implicit in the claim as originally worded).

Before considering the art rejections, Applicants would like to provide a brief description of the claimed invention and the advantages that the invention provides. The claimed invention is directed to a method for packaging an automobile part for shipment. The automobile part is placed on the front of a piece of paperboard such that areas on the front of the paperboard are left exposed. Shrink wrap then is applied over the automobile part and the exposed areas of the paperboard. Using the claimed method, the resulting paperboard laminate assembly prevents objects being shipped from moving, shifting, or otherwise changing position during loading, shipping, and storage. The inventive method may be utilized for packaging small items, but its advantages are most fully appreciated when the automobile part is large and heavy, *e.g.*, a window glass, door panel, hood, fender, etc. Surprisingly, with the claimed method, a paperboard backing combined with the noted shrink-wrapping is sufficient to protect such cumbersome items from breakage, scratches, dents, and abrasions.

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,154,898 issued Engles, Jr. (hereinafter, "Engles, Jr.").

In making this rejection, the Examiner notes that Engle discloses that it is well-known in the prior art to utilize a backing comprised of paperboard. While the use of paperboard is cited in the background of Engles, Jr., Engles, Jr. specifically teaches away from the use of paperboard because of the problems associated with it. In particular, Engles, Jr. notes that paperboard backing are "not water impervious, tend to curl under stress, and require the use of an adhesive to secure a firm bond between the backing and the film overlay." Col. 1, lines 15-18. To overcome these problems, Engles, Jr. specifically rejects paperboard as an effective backing or substrate and uses foam instead. See, Col. 1, lines 19-23. When viewed as a whole, Engles, Jr. teaches that attempts to use paperboard were unsuccessful.

Further, there is no suggestion in Engles, Jr. that paperboard could be used with large automotive parts, such as windshields, doors, fenders, etc. Engles, Jr. discloses the packaging of an "article". The only article specifically disclosed is a spark plug. See, Figs. 1-3 and the Examples at Col. 3, line 24-Col. 4, line 2. Thus, Engles, Jr. teaches away from paperboard even for small articles, let alone larger automotive parts.

Claim 3, dependent on claim 1, further recites that the automobile part is composed of material selected from the group consisting of metal, composite, glass, or combinations thereof. As noted above, the only article disclosed in Engles, Jr. is a spark plug. A major advantage of the present method is that it may be used to package large glass parts, such as windshields. There is no disclosure nor suggestion in Engles, Jr. for packaging any type of glass articles.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr.. Particularly, the Examiner has taken Official Notice that it is old and well-known to package various types of automotive parts for the purpose of protecting the part from damage. The Examiner argues that nothing disclosed by the applicants makes packaging a specific article patentably distinct from the generic article, and, therefore, providing the Engles, Jr. invention with window glass, door panel, fender or hood would have been obvious.

In response, Applicants would first note that, as described above, Engles, Jr. emphatically teaches against the use of paperboard for the packaging of any article. Applicants would further note that, rather than being obvious, the successful use of paperboard for backing a large and heavy item is unexpected and surprising. Such disparity of weight and size exists between paperboard and a large automotive part, that use of paperboard with such parts as a backing is counterintuitive. This is true even when the paperboard is laminated for additional strength. In this regard, the Examiner has cited no reference that discloses the packaging of a large automotive part using paperboard. As a result, Applicants submit that the items recited in claim 4 (window glass, door panel, fender or hood) are patentably distinct from the generic

article disclosed in Engles, Jr. and, it would not have been obvious to substitute any of these items for Engles, Jr.'s spark plug.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of U.S. Patent No. 4,611,456 issues to Gillio-tos, et al. (hereinafter, "Gillio-tos"). The Examiner cites Engles, Jr. as disclosing all the elements of claim 2 except a laminate backing. The Examiner cites Gillio-tos as disclosing a laminate backing.

Applicants would first note that claim 2, dependent on claim 1, recites the step of providing paperboard. That step, as discussed above, is neither disclosed nor taught by Engles. Claim 2 further recites that "said paperboard comprises laminated plies of paperboard." Gillio-tos discloses a substrate that may be provided as a laminated multilayer material. However, Gillio-tos also states that, "As for the material that may be used in the substrate construction, the single requisite is that it be a thermoformable material...". Col. 3, lines 16-20. Paperboard is not a thermoformable material. Thus, neither Engles, Jr. nor Gillio-tos disclose or suggest the use of a paperboard backing composed of laminated plies of paperboard.

Finally, claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of U.S. Patent No. 6,010,003 issued to Wilkinson (hereinafter, "Wilkinson"). Claim 5 is dependent on claim 1 and further includes the step of placing the shrink-wrapped automobile part in a container. Claim 5 is patentable for the reasons given above in connection with claim 1.

In view of the amendments and remarks submitted herewith, allowance of the claims and passage to issue of this application respectfully requested.

Respectfully submitted,

Date:

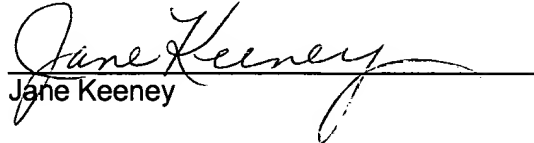
Jan 23, 2003

Diane E. Burke  
Diane E. Burke  
Reg. No. 45,725  
Mueller and Smith, L.P.A.  
Mueller-Smith Building  
7700 Rivers Edge Drive  
Columbus, Ohio 43235-1355  
Tel.: 614-436-0600  
Fax: 614-436-0057  
email: dburke@muellersmith.com

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on  
January 23, 2003 with the United States Postal Service as first class mail in an  
envelope addressed to:

Box Non-Fee Amendment  
Commissioner for Patents  
Washington, D.C. 20231

  
Jane Keeney

**MARKED-UP SET OF AMENDED CLAIMS**  
**SERIAL NO. 09/865,229**

1. Method for packaging an automobile part for shipment, which comprises the steps of:
  - (a) providing a paperboard having a front and a back;
  - (b) placing an automobile part on the front of said paperboard leaving exposed areas of said front of said paperboard laminate; and
  - ~~(b)~~ (c) shrink-wrapping with plastic shrink wrap material said ~~an~~ automobile part ~~product~~ to said paperboard laminate and said exposed areas of said front of said paperboard laminate.
2. The method of claim 1, wherein said paperboard ~~laminate~~ comprises laminated plies of paperboard.
3. The method of claim 1, wherein said automobile ~~parts are composed of one or more of~~ metal, composite, or glass part is composed of material selected from the group consisting of metal, composite, glass or combinations thereof.
4. The method of claim 3, wherein said automobile ~~parts are one or more of window glass, door panel, hood, or fender~~ part is selected from the group consisting of window glass, door panel, hood, fender or combinations thereof.
5. The method of claim 1, wherein said shrink-wrapped automobile part of step (c) is placed in a container.



#450  
Drawing  
S. Zimmerman

3721

Please type a plus sign (+) inside this box → ☐

PTO/SB/21 (08-00)  
Approved for use through 10/31/2002. OMB 0651-0031  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	<b>Application Number</b>	09/865,229	
	<b>Filing Date</b>	May 25, 2001	
	<b>First Named Inventor</b>	Donald R. Youell, Jr.	
	<b>Group Art Unit</b>	3721	
	<b>Examiner Name</b>	Paul Durand	
<b>Total Number of Pages in This Submission</b>	14	<b>Attorney Docket Number</b>	ACP 2-021

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input checked="" type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks</b> Clean and Marked-up claims New set of drawings with missing reference numbers		TECHNOLOGY CENTER R3700

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Diane E. Burke Mueller and Smith, LPA
Signature	<i>Diane E. Burke</i>
Date	January 23, 2003

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: <u>January 23, 2003</u>			
Typed or printed name	Jane Keeney		
Signature	<i>Jane Keeney</i>	Date	January 23, 2003

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

RECEIVED

JAN 31 2003